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EXAMINER

EVANISKO, LESLIE J

ART UNIT PAPER NUMBER

2854

DATE MAILED: 07/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/626,551	Applicant(s) KONDO ET AL.	
	Examiner Leslie J. Evanisko	Art Unit 2854	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2006.
 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
 4a) Of the above claim(s) 4, 14-18 and 22 is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 1-3, 5 and 19-21 is/are rejected.
 7) ☒ Claim(s) 6-13 is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☒ The drawing(s) filed on 25 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. <u>05-17-2006</u> . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>10-23-2003</u> . | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of the species of Figures 1-12 in the reply filed on April 25, 2006 is acknowledged.

2. It is noted that applicant stated in the reply filed April 25, 2006 that claims 1-4, 14-18, and 22 are readable on the elected species of Figures 1-12. However, the Examiner disagreed with that statement and called applicant's representative Chuck Watts to discuss the matter on May 15, 2006. In particular, the Examiner pointed out that claims 4, 14-18, and 22 appear to be drawn to the non-elected inkjet embodiment of Figures 13-17. The Examiner stated that she felt claims 1-3 and 5-13 read on the embodiment shown in Figures 1-12. Applicant's representative called the Examiner on May 17, 2006 and agreed that the Examiner should examine claims 1-3 and 5-13, drawn to the embodiment(s) shown in Figures 1-12. Furthermore, it was later noted by the Examiner that claims 19-21 are also drawn to the elected embodiment and therefore those claims will be examined along with claims 1-3 and 5-13 in the following Office Action.

Therefore, in view of the conversation with applicant's representative on May 17, 2006, claims 4, 14-18, and 22 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable

generic or linking claim. Election was made **without** traverse in the reply filed on April 25, 2006 and the interview on May 17, 2006.

Priority

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

4. The drawings are objected to because of the following minor informalities: It is noted that the two views of Figure 8 are not appropriately labeled according to the guidelines set forth in MPEP 608.02 and 37 CFR 1.84(u)(1). In particular, each view on the drawing sheet of Figure 8 should have a separate label of "Fig. 8(a)" and "Fig. 8(b)". Note similarly, the brief description of Figure 8 on page 11 of the specification should also be amended to refer to Figures 8(a) and 8(b).

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering

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of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: reference numeral **324** in Figures 14 and 17; reference numeral **343** in Figure 14; and reference numeral **335** in Figures 14 and 15. To correct the problem with reference numeral **324**, it is suggested the term "role **24**" in line 12 of page 34 be deleted and replaced with --roll **324**--. To correct the problem with reference numeral **335**, it is suggested that numeral be added to the specification after the term "shafts" in the second to last line of page 34.

Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be

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notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

6. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

7. The disclosure is objected to because of the following informalities: First, it is evident from reading of the specification that the application is a translation of a foreign language and has many instances of awkward and unclear language. Some examples of awkward language are as follows:

- page 1, in the last line of first paragraph under section 2, the phrase “on the beauty from transient boom.”
- page 1, in the last two lines of the second paragraph under section 2, the sentence “Consequently, it sometimes costs very high.”
- page 21, line 14, the phrase “it is possible to closes up tip of the nozzle...”
- page 22, line 22, the phrase “fat should be made to eliminate from the...”
- page 22, lines 23-24, the sentence “A squeegee 170 performs elimination of fat.”

The above are merely examples of the types of problems present in the specification and is, in no way, an exhaustive listing. Therefore, in response to this Office Action, applicant is required to carefully review the specification and amend it as necessary to insure the specification uses proper idiomatic English.

Additionally, on page 6, line 24, it is suggested that the term "six" be deleted and replaced with --sixth-- to correct an obvious grammatical error. On page 13, line 29, it is suggested that the term "be" be deleted and replaced with --while-- or similar language to correct an obvious grammatical error. On page 17, line 29, it is suggested that the term "hand section 141" be deleted and replaced with --hand section 143-- since that is how the hand section is later defined in the second paragraph on page 18 and how it is shown in the drawings. On page 33, line 28, it is suggested that the term "ink jet printer 312" be deleted and replaced with --ink jet printer 301-- since that is how the ink jet printer was previously defined (in line 25) and illustrated in the drawings. It appears the use of the term "role paper 321" throughout pages 33-37 may be in error as it appears that perhaps the applicant intended to meant to use the term "roll" instead of "role".

Appropriate correction and/or clarification is required.

Claim Objections

8. Claims 1-3, 5-13, and 19-21 are objected to because of the following informalities:

The claims are replete with instances of awkward language and terms lacking proper antecedent basis. The following are merely examples of the types of problems that exist in the claims and is in no way an exhaustive listing. In response to this Office

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Action, applicant is required to carefully review the claims and amend them as necessary to correct all such problems.

With respect to claim 1, the terms “the fingertip” and “the user” in line 2 have no proper antecedent basis since no fingertip or user was previously recited. To correct these problems, it is suggested that the term “the” in each of these terms be deleted and replaced with --a--.

With respect to claim 2, it is suggested that the following terms have the term --a-- inserted before them to provide an appropriate article before each noun: “plate surface selecting step” in line 2, “concave section” in line 3, “re-transcribing step” in line 6. In claim 2, line 2, the term “the plate surface” has no proper antecedent basis since no plate surface was previously recited in the claim. Also in claim 2, line 3, it is suggested that the term --the-- be inserted before “printed picture or pattern” since the picture or pattern were previously recited in claim 1. Additionally in claim 2, line 6, the term “the pad” and “the transcription surface” have no proper antecedent basis since such terms were never previously recited in the claims.

With respect to claim 3, the term “said nails” has no proper antecedent basis since only a nail (singular) was previously recited in the claims.

With respect to claim 5, the following terms have no proper antecedent basis: “this pad,” “the nail” (line 3) ; “the fingertip,” “the user” (line 4); “said plurality of plate surfaces” (lines 5-6); “the selected ink” (line 7); “said pad,” “said nail” (line 10); “this pad,” “the nail,” “the user’s fingertip” (line 11); “said pad” (lines 12-13). Additionally, it is suggested that the term “container” in line 8 be deleted and replaced with --containers-- to correct an obvious grammatical error.

With respect to claim 6, it is suggested that the term “medium” (first occurrence) in line 4 be deleted and replaced with --mediums-- since it appears this term should be plural based upon the context of the sentence. Additionally, in line 4, it is suggested that the awkward phrase “to be the medium on which said plate surface is formed more than one; and” be deleted and replaced with --; each plate surface formation medium having a plurality of said plate surfaces formed thereon-- or similar language. In line 5 it is suggested that the phrase “one plate surface formation medium” be deleted and replaced with --one of said plate surface formation mediums--. Similarly, in line 6, it is suggested that the term “medium” (first occurrence) be deleted and replaced with --mediums--. Again, the term “the selected ink” in line 7 has no proper antecedent basis. Additionally, in line 7, it is suggested the term “said ink container” be deleted and replaced with --one of said ink containers-- since only a plurality of ink containers were previously recited. Finally, in line 8, it is suggested that the term --one-- be inserted before “plate surface formation medium” to use consistent terminology throughout the claims and insure the claim language is clear and concise.

With respect to claim 8, it is suggested that the term --a-- be inserted before “part” in line 2 to provide less awkward claim language. Similarly, it is suggested the term --a-- be inserted before “magnetic line” in line 4. Also in line 4, it is suggested that the term --said-- be inserted before “part” to provide less awkward language. It is suggested that the term “electromagnet” in line 5 be deleted and replaced with --electromagnets-- since it appears from the context of the sentence that this term should be plural.

With respect to claim 9, the terms “the dropping ink” in lines 1-2 and “said table” in line 2 have no proper antecedent basis.

With respect to claim 11, the terms “the ink nozzle arrangement” in lines 1-2, “the ink application position,” and “the rest position” in line 2 and “said table” in line 3 have no proper antecedent basis.

With respect to claim 12, the term “said plate surface formation medium” in line 2 has no proper antecedent basis since only a plurality of plate surface formation mediums were previously recited.

With respect to claim 13, the terms “the rotational axis section” in line 2 and “said table” in line 3 have no proper antecedent basis.

With respect to claim 20, the term “said pad” has no proper antecedent basis since no pad was ever positively recited in claim 5.

With respect to claim 21, the term “or so forth” in line 3 is awkward and somewhat unclear in meaning.

Appropriate correction and/or clarification is required.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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10. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Jenkins et al. (US 5,302,224). Jenkins et al. teach a nail art operating method comprising the steps of a fingertip fixation step for fixing the fingertip **100** of a user on a pedestal **26** and a printing step for printing a picture or a pattern **101**, **202**, **302** by a pad printing method on a nail **102** of the fingertip **100** fixed at the fingertip fixation step. See Figures 1, 5-8, and 12-16 as well as column 1, lines 20-44 in particular.

With respect to claim 2, note Jenkins et al. teach the printing step is performed by selecting a plate surface (i.e., portion of plate having desired image) on which a concave section corresponding to the printed picture or pattern is formed (such as by rotating the circular plate **300** shown in Figure 12 to the desired image **302**), performing an ink applying step for applying ink to the selected plate surface (see column 4, lines 37-38), performing a transcribing step for picking up the inked image from the plate using a pad **134** (see column 4, lines 47-53) and performing a re-transcribing step of transferring the inked image from the pad **134** to the fingernail **102** of a user (see column 4, lines 60-62).

With respect to claim 3, note Jenkins et al. teach the inking and printing steps may be repeated to print different pictures or patterns with different color inks in column 1, lines 42-44 and column 4, lines 63-65.

11. Claim 5 is rejected under 35 U.S.C. 102(b) as being anticipated by Ciniglio et al. (GB 2 124 977 A). Ciniglio et al. teach an operating apparatus **8** which applies ink to a plate surface **1** on which a concave section is formed, transcribe the ink existing on the concave section of this plate surface, and re-transcribes the ink transcribed on this pad

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9 for the object comprising “fingertip” fixation means (table 7 including nest described in lines 59-65 of page 1) for fixing an object desired to be printed (which is broadly capable of being a fingertip of a user), plate surface selecting means (i.e., programmable microprocessor described in lines 125-126 of page 1 which controls movement of the pad to the pick up the image from the selected plate surface) for selecting the plate surface **11** in use from a plurality of plate surfaces, ink applying means (see lines 72-73 and lines 92-96 of page 1) for applying a selected ink to the plate surface selected by the plate surface selecting means while selecting the ink introduced from a plurality of ink containers for containing the ink (clearly the multiple colors of ink described by Ciniglio et al. would inherently be stored in separate containers of some type), and re-transcribing means for re-transcribing the ink transcribed on the pad for the object so as to bring this pad into contact with the object fixed on the fixation means, after transcribing the ink applied on the plate surface by the ink applying means to the pad. See Figure 2 and lines 47-130 of page 1 in particular.

Note that although Ciniglio et al. do not specifically teach the apparatus is used to print nail art upon the fingernail of a user, it is noted that the claim is an apparatus claim and what object the apparatus is intended to print upon is merely a functional intended use. Since the apparatus of Ciniglio et al. teach all of the structure as recited including “fingertip” fixation means which is capable of fixing a fingertip of a user and the apparatus is used to print upon various non-planar surfaces, it is broadly capable of being used as a “nail art operating apparatus” to print upon a non-planar surface such as a fingernail of a user and therefore meets the claim language as recited.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

14. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ciniglio et al. (GB 2 124 977 A) in view of Jenkins et al. (US 6,085,757). Ciniglio et al. teach a “nail art” operating apparatus as recited with the possible exception of the “fingertip” fixation means being provided with a nail position specification means for determining the position of the nail of a user. Although Ciniglio et al. is silent with respect to the particular details of the nest for holding the object to be printed, note Jenkins et al. teach a printing apparatus including a fingertip fixation means **194** provided with a nail

position specification means **218** for determining the position of the nail of a user in column 7, lines 34-55 and column 10, lines 8-18. In view of this teaching, it would have been obvious to one of ordinary skill in the art to provide a position specification means **218** as taught by Jenkins et al. in the printing device of Ciniglio et al. to allow more precise positioning of the object to be printed and better registration of the printed images.

15. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ciniglio et al. (GB 2 124 977 A) in view of Cameron (US 6,123,021). Ciniglio et al. teach a “nail art” operating apparatus as recited with the exception of providing cleaning means for cleaning the surface of the pad. However, the use of a cleaning assembly for cleaning the surface of a pad in a pad printer when printing multicolor images onto an object is well known in the art, as exemplified by the cleaning means **56** of Cameron shown in Figure 1 and described in column 4, lines 35-51. In view of this teaching, it would have been obvious to one of ordinary skill in the art to provide a cleaning means as taught by Cameron in the pad printing device of Ciniglio et al. to provide faster, clearer, and more accurate printing of multicolor images onto a small object having a curved surface.

16. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ciniglio et al. (GB 2 124 977 A) in view of Sim (US 2005/0036813 A1). Ciniglio et al. teach a “nail art” operating apparatus as recited with the possible exception of including accounting operation means causing the machine to operate in response to receiving coins or paper money. However, the use of an art operating apparatus in an automatic vending

machine arrangement is well known in the art as exemplified by Sim in paragraphs [0001] and [0024]. Although Sim is silent with respect to the details of the vending machine structure, any vending machine would inherently include accounting operation means causing the machine to operate in response to receiving coins or paper money. Therefore, in view of this teaching, it would have been obvious to one of ordinary skill in the art to provide vending machine structure as taught by Sim to the printing machine of Ciniglio et al. to allow a user to provide a profitable printing machine that can be used by various customers to print various customized indicia upon desired objects.

Allowable Subject Matter

17. Claims 6-13 are objected to for the reasons set forth above as well as for being dependent upon a rejected base claim, but would be allowable if rewritten to overcome the above objects to the satisfaction of the Examiner and in independent form including all of the limitations of the base claim and any intervening claims.

18. The following is a statement of reasons for the indication of allowable subject matter:

With respect to claim 6 in particular, the prior art of record fails to teach or fairly suggest a nail art operating apparatus having all of the structure as recited, in combination with and particularly including, the plate surface selecting means comprising a medium mounting means capable of mounting a plurality of plate surface formation mediums, each plate surface medium having a plurality of plate surfaces formed thereon, and a medium taking out means for taking out one of said plurality of

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plate surface formation mediums from among the plate surface formation mediums mounted on said medium mounting means.

With respect to claim 11 in particular, the prior art of record fails to teach or fairly suggest a nail art operating apparatus having all of the structure as recited, in combination with and particularly including, the ink applying means including an ink nozzle arrangement and being movable between an ink application position and a rest position on the table by rotation of the ink applying means about a fulcrum as the center.

Conclusion

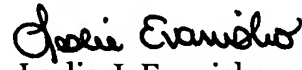
19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Jenkins et al. (US 6,363,943 B1, 6,029,673, 6,024,099) and Glover (US 4,928,587) each teach a pad printing arrangement for marking indicia on small objects having obvious similarities to the claimed subject matter.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Leslie J. Evanisko** whose telephone number is **(571) 272-2161**. The examiner can normally be reached on T-F 8:00 am-6:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew H. Hirshfeld can be reached on (571) 272-2168. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Leslie J. Evanisko
Primary Examiner
Art Unit 2854

lje
June 22, 2006